

REMARKS

In response to the Office Action dated May 14, 2008, the Assignee respectfully requests reconsideration based on the above amendments and on the following remarks.

Claims 1-3 and 6-35 are pending in this application. Claims 4-5 have been previously canceled without prejudice or disclaimer.

Rejection of Claims under § 103 (a) over *Smith, McKendry & Henderson*

The Office continues to reject claims 1-3, 9, 12-15, 18-22, 26, 29-32, and 35 under 35 U.S.C. § 103 (a) as allegedly being obvious over U.S. Patent 6,219,409 to Smith, *et al.* in view of U.S. Patent 6,021,176 to McKendry, *et al.* and further in view of U.S. Patent 4,107,476 to Henderson.

The Office argues that one of ordinary skill in the art would be motivated to modify and combine *Smith, McKendry*, and *Henderson*. The Office interprets *Smith*'s "CPU Board 186" and "PNI Communications Cards 187" as the claimed "*base unit*." The Office also interprets *McKendry*'s programmable personal call manager ("PCAM") as the claimed "*base unit*," and *McKendry*'s telephones and computer interface are interpreted as the claimed "*extension control device*." The Office then proposes to combine *Henderson*'s "tone ringer" with *Smith* and *McKendry* to obviate the rejected claims.

As the Assignee has previously explained, though, the proposed combination of *Smith, McKendry*, and *Henderson* "teaches away" and cannot support a *prima facie* case for obviousness. The M.P.E.P. expressly explains several situations in which a reference "teaches away," including when a proposed modification "render[s] the prior art unsatisfactory for its intended purpose" or when the proposed modification "change[s] the principle of operation of a reference." See M.P.E.P. § 2145 (X)(D). If *Smith* is combined with *McKendry* and *Henderson*,

as the Office proposes, then many changes to a principle of operation are required, and these changes render *Smith*, *McKendry*, and/or *Henderson* unsatisfactory for their intended purposes. The proposed combination of *Smith*, *McKendry*, and *Henderson* cannot support a *prima facie* case for obviousness, so the Office is required to remove the § 103 (a) rejection of these claims.

The Assignee, for example, already demonstrated that *Smith*'s principle of operation must be changed. The Assignee previously put forth compelling evidence that the proposed combination of *Smith*, *McKendry*, and *Henderson* would require elimination of a switch in *Smith*'s "ring detection circuit." *Smith* utilizes this ring detection circuit to inform a microprocessor of a ring event. See, e.g., U.S. Patent 6,219,409 to *Smith, et al.* at column 12, lines 57-60. *Smith* then opens a switch to "prevent the telephone call from being transferred to the bus 185," which communicates with a CPU Board 186 and with PNI Communications Cards 187. See *id.* at column 12, lines 60-65. See also *id.* at FIGS. 9 and 10. Because the Office interprets *Smith*'s "CPU Board 186" and "PNI Communications Cards 187" as the claimed "*base unit*," *Smith*'s ring detection circuit, then, would not pass ring signals to the bus 185 for distribution. If *McKendry*'s programmable personal call manager and/or *Henderson*'s tone ringer are connected to *Smith*'s circuitry, as the Office proposes, then *Henderson*'s tone ringer would not "[build] up a charge that generates a ring event on the telephone line" as independent claims 1 and 20 recite. The Office's proposed combination, then, would require at least eliminating *Smith*'s switch 221, which changes *Smith*'s principle of operation and renders it unsatisfactory for its intended purpose. The proposed combination of *Smith*, *McKendry*, and *Henderson*, then, cannot support a *prima facie* case for obviousness, so the Office is required to remove the § 103 (a) rejection of these claims.

The Office, however, now responds and says these arguments "are not persuasive." The Office first states that a "reference only teaches away from a claimed feature if said reference specifically excludes said feature." Examiner Genack, Office Action mailed May 14, 2008, at page 11, lines 9-10. The Office, however, provides absolutely no support for this assertion, and this assertion is counter to the M.P.E.P. requirements. See M.P.E.P. § 2145 (X)(D). The

Office's bald assertion, then, is not supported by Office procedures or by case law. For this reason alone, then, the Office must remove the § 103 (a) rejection of these claims.

The Office next argues that *Henderson's* capacitor “may be charged” before *Smith's* switch opens. See Examiner Genack, Office Action mailed May 14, 2008, at page 12, line 6. The Office asserts that if a “time constant” for *Henderson's* capacitor is appropriately chosen, then *Henderson's* capacitor could be charged before *Smith's* switch opens. See Examiner Genack, Office Action mailed May 14, 2008, at page 12, lines 3-7. The Office's assertion, however, is complete speculation. The Office offers no textual support for this assertion, and this assertion completely ignores *Smith's* expressed teaching. The proposed combination of *Smith*, *McKendry*, and *Henderson* would require elimination of *Smith's* switch 221. If *Smith's* switch 221 is eliminated, then it is complete speculation that *Henderson's* capacitor “may be charged” before *Smith's* switch opens, as the Office proposes. The Office, quite simply, unreasonably discounts the modifications that would be required in favor of the Office's own speculation. The Office, then, is thus respectfully requested to remove the § 103 (a) rejection of these claims.

Lastly, the Office argues that *Smith's* “ring generator” is not relied on to reject the claims. The Assignee previously argued that *Smith*, *McKendry*, and *Henderson* would require more impermissible changes. Independent claims 1 and 20 recite “*the extension control device receiving power from a current on a telephone line.*” FIG. 11 of *Smith*, however, illustrates a processor-controlled “ring generator” that couples directly to a processor and the processor receives power from a power supply. If *Henderson's* tone ringer were connected to *Smith's* circuitry, as the Office proposes, then *Smith's* processor-controlled “ring generator” would have to be changed to provide “*power from a current on a telephone line.*” The Office discounts this argument, implying that *Smith's* “ring generator” was not relied on to reject the claims.

Again, though, the Office is mistaken. **A reference must be considered as a whole, including portions that lead away from the claimed invention.** See M.P.E.P. at § 2141.02; see also *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 220 U.S.P.Q. (BNA) 303 (Fed. Cir. 1983),

cert. denied, 469 U.S. 851 (1984). The Office interprets *McKendry's* telephones and computer interface as the claimed “*extension control device*.” Clearly, though, *McKendry's* computer does not “*receive[er] power from a current on a telephone line*,” as independent claims 1 and 20 recite. It seems the Office wants to “cherry pick” only certain teachings of *McKendry* and ignore teachings that are unfavorable. The patent laws, however, forbid such action, and the Office is, instead, required to consider the whole teachings of a reference. Because *McKendry's* principle of operation must somehow be changed to provide at least a computer that receives “*power from a current on a telephone line*,” the Office must respectfully remove the § 103 (a) rejection of these claims.

Even more changes are required. The independent claims similarly recite “*the first algorithm selectively communicating an incoming telephone call received from the telephone network to a selected telephone jack via the base unit, the base unit accessing one or more user-defined rules to select the telephone jack and to route the incoming communication to the selected telephone jack*” (emphasis added). If the Office proposes to combine *Smith* with *McKendry* and *Henderson*, then even more impermissible changes are required to *McKendry's* principle of operation. Again, recall that the Office also interprets *McKendry's* programmable personal call manager (“PCAM”) as the claimed “*base unit*.” *McKendry's* PCAM, however, does not “*selectively communicating an incoming telephone call ... to a selected telephone jack*” (emphasis added). ***McKendry, instead, rings all telephone “extensions” for an incoming call. When one of the telephones answers the incoming call, then McKendry's PCAM stops ringing “all other telephone instruments.” See U.S. Patent 6,021,176 to McKendry, et al. at column 13, lines 9-12 and lines 17-19. So, McKendry's principle of operation must be changed to “selectively communicat[er] an incoming telephone call ... to a selected telephone jack” (emphasis added). Because McKendry's principle of operation must be changed, the Office must respectfully remove the § 103 (a) rejection of these claims.***

The Assignee has thus put forth compelling evidence that the proposed combination of *Smith*, *McKendry*, and *Henderson* “teaches away” from their combination. If *Smith* is combined with *McKendry* and *Henderson*, as the Office proposes, then many changes to a principle of

operation are required, and these changes render *Smith, McKendry*, and/or *Henderson* unsatisfactory for their intended purposes. Because such changes are not permissible, any proposed combination of *Smith, McKendry*, and *Henderson* cannot support a *prima facie* case. The Office is thus respectfully requested remove the rejection of claims 1-3, 9, 12-15, 18-22, 26, 29-32, and 35.

Rejection of Claims 6-8 & 23-25 under § 103 (a)

Claims 6-8 and 23-25 were rejected under 35 U.S.C. § 103 (a) as being allegedly obvious over *Smith, McKendry*, and *Henderson* and further in view of U.S. Patent 6,473,078 to Ikonen, *et al.*

Claims 6-8 and 23-25, however, cannot be obvious. Claims 6-8 and 23-25, respectively, depend from independent claims 1 and 20. As the above paragraphs explained, *Smith, McKendry*, and *Henderson* “teach away” from their combination, and *Ikonen* does not resolve or reduce the many impermissible changes that render these documents unsatisfactory for their intended purposes. The patent to Ikonen, *et al.* discusses power management for a cathode ray tube display. Even so, the combined teaching of *Smith, McKendry, Henderson*, and *Ikonen* still “teaches away” from their combination. One of ordinary skill in the art, then, would not be motivated to modify *Smith, McKendry, Henderson*, and *Ikonen* as the Office proposes. Claims 6-8 and 23-25, then, cannot be obvious, so Examiner Genack is respectfully requested to remove the § 103 (a) rejection of these claims.

Rejection of Claims 11, 16, 28 & 33 under § 103 (a)

Claims 11, 16, 28, and 33 were rejected under 35 U.S.C. § 103 (a) as being allegedly obvious over *Smith, McKendry*, and *Henderson* and further in view of U.S. Patent 5,978,451 to Swan, *et al.*

Claims 11, 16, 28, and 33, however, cannot be obvious. Claims 11, 16, 28, and 33, respectively, depend from independent claims 1 and 20. As the above paragraphs explained, *Smith*, *McKendry*, and *Henderson* “teach away” from their combination, and *Swan* does not resolve or reduce the many impermissible changes that render these documents unsatisfactory for their intended purposes. *Swan* discusses a personal communications controller for all the terminals in a residence. Even so, the combined teaching of *Smith*, *McKendry*, *Henderson*, and *Swan* still “teaches away” from their combination. One of ordinary skill in the art, then, would not be motivated to modify *Smith*, *McKendry*, *Henderson*, and *Swan* as the Office proposes. Claims 11, 16, 28, and 33, then, cannot be obvious, so Examiner Genack is respectfully requested to remove the § 103 (a) rejection of these claims.

Rejection of Claims 10 & 27 under § 103 (a)

Claims 10 and 27 were rejected under 35 U.S.C. § 103 (a) as being allegedly obvious over *Smith*, *McKendry*, and *Henderson* and further in view of U.S. Patent 6,823,354 to Kynast, *et al.*

Claims 10 and 27, however, cannot be obvious. Claims 10 and 27, respectively, depend from independent claims 1 and 20. As the above paragraphs explained, *Smith*, *McKendry*, and *Henderson* “teach away” from their combination, and *Kynast* does not resolve or reduce the many impermissible changes that render these documents unsatisfactory for their intended purposes. *Kynast* discusses a master station for a service provider. The combined teaching of *Smith*, *McKendry*, *Henderson*, and *Kynast*, however, still “teaches away” from their combination. One of ordinary skill in the art, then, would not be motivated to modify *Smith*, *McKendry*, *Henderson*, and *Kynast* as the Office proposes. Claims 10 and 27, then, cannot be obvious, so Examiner Genack is respectfully requested to remove the § 103 (a) rejection of these claims.

Rejection of Claims 17 & 34 under § 103 (a)

Claims 17 and 34 were rejected under 35 U.S.C. § 103 (a) as being allegedly obvious over *Smith*, *McKendry*, and *Henderson* and further in view of U.S. Patent 6,122,347 to *Borland*.

Claims 17 and 34, however, cannot be obvious. Claims 17 and 34, respectively, depend from independent claims 1 and 20. As the above paragraphs explained, *Smith*, *McKendry*, and *Henderson* “teach away” from their combination, and *Borland* does not resolve or reduce the many impermissible changes that render these documents unsatisfactory for their intended purposes. *Borland* discusses announcement of a caller before a ring is generated. The combined teaching of *Smith*, *McKendry*, *Henderson*, and *Borland*, however, still “teaches away” from their combination. One of ordinary skill in the art, then, would not be motivated to modify *Smith*, *McKendry*, *Henderson*, and *Borland* as the Office proposes. Claims 17 and 34, then, cannot be obvious, so Examiner Genack is respectfully requested to remove the § 103 (a) rejection of these claims.

If any issues remain outstanding, the Office is requested to contact the undersigned at (919) 469-2629 or scott@scottzimmerman.com.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Scott P. Zimmerman", with a stylized flourish at the end.

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